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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/853,568	08/03/2001	Catherine Shoemaker	1960-00100	6318

23505 7590 02/25/2003

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EXAMINER

CARTER, MONICA SMITH

ART UNIT	PAPER NUMBER
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3722

DATE MAILED: 02/25/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

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GROUP 3700

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Paper No. 14

Application Number: 09/853,568
Filing Date: August 03, 2001
Appellant(s): SHOEMAKER, CATHERINE

Jonathan M. Pierce
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed January 24, 2003.

(1) *Real Party in Interest*

A statement identifying the real party in interest is contained in the brief.

(2) *Related Appeals and Interferences*

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

(3) *Status of Claims*

The statement of the status of the claims contained in the brief is correct.

(4) *Status of Amendments After Final*

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) *Summary of Invention*

The summary of invention contained in the brief is correct.

(6) *Issues*

The appellant's statement of the issues in the brief is correct.

(7) *Grouping of Claims*

Appellant's brief includes a statement that claims 1, 2, 4-11 and 13-21 do not stand or fall together and provides reasons as set forth in 37 CFR 1.192(c)(7) and (c)(8).

(8) Claims Appealed

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) Prior Art of Record

5,261,702

MAYFIELD

11-1993

(10) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 2 and 17-18 are rejected under 35 U.S.C. 102(b) as being anticipated by Mayfield (5,261,702).

Mayfield discloses the claimed invention including a housing inherently having an open end (end which the medicine is to be entered) and an external surface (outside surface of the medication container), the housing is configured to retain dosages of medicine; a cover removably secured to the open end which separates the medicine held within from the outside environment; and a descriptive iconic label (22) disposed on the cover to graphically describe the medicine held therein (see figs. 4 and 5 and col. 7, lines 39-41). The prescription description (Rx) on the label would indicate the

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enclosed medicine without reference to another source. Further, Mayfield discloses "...symbol shape alone or color alone may be provided on the adhesive tabs 22 to code the particular medication." (see col. 7, lines 39-42).

Regarding claim 2, Mayfield discloses an iconic label disposed on the external surface (see figs. 4 and 5 and col. 7, lines 42-46).

Regarding claims 17 and 18, see the above rejections. Further, Mayfield discloses the icon being descriptive and non-textual (triangle and star) as seen in figures 4 and 5.

Regarding claim 19, see the above rejections.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 4-16, 20 and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mayfield, as used above.

Regarding claims 7-10, Mayfield discloses the method of applying the label (22) to the exterior of the receptacle (col. 7, lines 36-38).

Regarding claim 11, the label has first and second sides, the first side having an adhering surface (col. 7, lines 31-33) and the second side having an external printable media (22).

Mayfield discloses the claimed invention except for the specific arrangement and/or content of indicia (printed matter) set forth in claims 4-9, 11-16, 20 and 21. It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide any type of graphic representation on the cover, since it would only depend on the intended use of the assembly and the desired information to be displayed. Further, it has been held that when the claimed printed matter is not functionally related to the substrate it will not distinguish the invention from the prior art in terms of patentability. *In re Gulack*, 217 USPQ 401, (CAFC 1983). The fact that the content of the printed matter placed on the substrate may render the device more convenient by providing an individual with a specific type of iconic label does not alter the functional relationship. Mere support by the substrate for the printed matter is not the kind of functional relationship necessary for patentability. Thus, there is no novel and unobvious functional relationship between the printed matter and the substrate that is required for patentability.

(11) Response to Argument

A. Rejection Under 35 U.S.C. § 112, 2nd Paragraph

Appellant's arguments with respect to the previous rejection under 35 U.S.C. 112, 2nd paragraph, are moot since, upon further review, the examiner has withdrawn this rejection.

B. Rejection of Claims 1, 2 and 17-19 Under § 102

Appellant argues that Mayfield consists of many components, including a chart 10, coded symbols 14 and container markers 22. Appellant states that Mayfield fails to

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disclose each and every element of the appellants claims. Appellant states that, at least one element of claims 1, 17 and 19 markedly differs from the container markers of Mayfield. Appellant further argues that Mayfield fails to disclose a descriptive iconic label capable of identifying the medicine in the container having the iconic label *without reference to another source*. Appellant further discloses that Mayfield's container markers 22 are made for the express purpose of referring to another source, namely chart 10. The examiner disagrees. Mayfield discloses an iconic label 22 that is capable of identifying the medicine in the container without reference to another source, since Mayfield discloses that the symbol shape or color alone may be provided on the adhesive tabs to code the particular medication in the container (see col. 7, lines 39-42). Further, providing symbols, icons, etc., on medicine containers that indicate a particular medicine is conventional. Medicine for infants and toddlers commonly have icons/graphics to indicate a particular type of medicine (i.e., a child coughing to indicate the medicine relieves cold symptoms such as coughing). Furthermore, it has been held that the recitation that an element is "capable of" performing a function is not a positive limitation but only requires the ability to so perform. Therefore, it would have been obvious to one having ordinary skill in the art at the time of the invention to modify, the reference applied is required to only be "capable" of performing the claimed function. *In re Hutchison*, 69 USPQ 138.

Regarding claim 17, appellant claims a descriptive, non-textual icon that graphically describes the medicine in the container. Appellant argues that Mayfield's container markers 22 are not descriptive and do not allow the patient to know, by only

looking at the label on the bottle, whether that is the correct medicine or not. Again, the examiner asserts that Mayfield discloses an iconic label 22 that is capable of identifying the medicine in the container without reference to another source, since Mayfield discloses that the symbol shape or color alone may be provided on the adhesive tabs to code the particular medication in the container (see col. 7, lines 39-42). The symbols are non-textual icons graphically describing the medicine in the container. Therefore, the examiner maintains the 35 U.S.C. 102 rejection of claim 17 (and corresponding dependent claim 18).

Regarding claim 19, appellant's argument is essentially the same as set forth regarding claims 1, 2, 17 and 18. The examiner, therefore, maintains the same line of reasoning as set forth above.

C. Rejection of Claims 4-16, 20 and 21 Under § 103(a) are Not Obvious In View of Mayfield and *In re Gulack* Does Not Support the Examiner's § 103(a) Rejection

Appellant argues that Mayfield fails to disclose the specific arrangement and/or content of indicia as claimed. Appellant disagrees with the examiner's use of *In re Gulack* to support the rejections. The examiner maintains that it would have been obvious to one having ordinary skill in the art at the time the invention was made to provide any type of desired graphic representation on the container as necessitated by the user. Appellant disagrees with the examiner's conclusion that the printed matter required by the claims of the present application is not functionally related to the substrate. Appellant cites *In re Miller*, 164 USPQ 46 (CCPA 1969) to substantiate his

position that the printed matter in the present invention is functionally related to the substrate. In *In re Miller*, the claims were directed toward a measuring cup or receptacle for measuring partial recipes. Measuring indicia on the receptacle indicated a quantity different from the actual quantity measured. The indicia on the substrate was required to be located in a particular position to convey meaningful information in regard to the substrate. In other words, in order to accurately measure a substance to be used in a recipe, the indicia on the receptacle is required to be placed at specific measured locations. In this case, the printed elements of the invention acted in combination with the structure on which they were printed (the "substrate") to perform a function that was neither anticipated nor made obvious by the prior art.

In the present invention, the claimed iconic label indicates the type of medication that is in the container. In contrast to *In re Miller*, the indicia placed on the label does not act in combination with the structure on which it is printed. It merely comprises printed matter that has been printed onto a substrate. The substrate supports the printed matter. However, the printed matter does not convey any meaningful information in regard to the substrate and does not require any particular substrate to effectively convey the information. Thus, there is no meaningful functional relationship between the indicia and the substrate, as set forth by the court in *In re Gulack*.

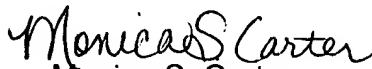
The examiner asserts that Mayfield's container having an iconic label is the same structure claimed by appellant and the sole difference is in the content of the printed material. Accordingly, there being no functional relationship of the printed material to the

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substrate, as noted above, there is no reason to give patentable weight to the content of the printed matter which, by itself, is non-statutory subject matter.


For the above reasons, it is believed that the rejections should be sustained.

Respectfully,


Monica S. Carter
Patent Examiner
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February 24, 2003

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